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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/784,507

02/23/2004

Ken Rosenblum

1326.001US5

1482

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7590

11/16/2007

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EXAMINER

MAI, THIEN T

ART UNIT

PAPER NUMBER

2876

MAIL DATE

DELIVERY MODE

11/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/784,507

Applicant(s)

ROSENBLUM, KEN

Examiner

Thien T. Mai

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/07.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgement

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/4/2007 has been entered.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 7, "other prescriptions" lacks antecedent basis. It is unclear as to which (i.e. dispensed, issued by other pharmacies/doctors, or future) prescriptions "other" is referring to.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim(s) 1-11 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Lion (US 6,330,491)

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Re claim 1-6, Lion discloses a method comprising: sending prescription information for a therapeutic agent for a patient to a dispensing apparatus (col. 3 line 38-35);

giving the patient a unique authorization code (col. 3 lines 38-35); the patient entering the authorization code into the dispensing apparatus (Fig. 2);

wherein the authorization step is done without intervention of a pharmacist; wherein the patient receives the therapeutic agent from the dispenser without the intervention of a pharmacist (col. 2 lines 35-65); wherein the authorization code is given to the patient by a health care provider at a health care facility (mail order or online);

Lion is silent with respect to the authorization code not capable of being reused for other prescriptions.

However, Lion teaches that the authorization code for a prescription is obtained online after the customer making the online transaction for the prescription (col. 3 lines 38-35).

It would have been obvious to one of ordinary skill in the art at the time the invention was made that the authorization code/transaction code is incapable of being reused at least by the patient for other prescriptions since the patient is inherently required to get online again to make another transaction and get another "transaction code" for other prescriptions or other prescription not in the transaction);

Lion is further silent with respect to the patient being able to selectively cancel the transaction and receive a traditional prescription printed by the dispensing

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apparatus; and if the patient does not cancel the transaction, the patient receiving the prescribed therapeutic agent from the dispensing apparatus.

However, Lion discloses in Fig. 2 a dispensing apparatus having keypad that accepts authorization code from the customer (col. 3 line 38-35) and credit card information. It would have been obvious to one of ordinary skill in the art at the time the invention was made that when the keypad is non-functional or broken and/or the dispenser is incapable of recognizing an input from the customer, the customer would still have the prescription receipt obtained online or mail order and bring it to the store front where the dispenser is located and request the prescription to be filled. It would be further obvious a cancel button be incorporated in the keypad of the dispenser as commonly seen in ATM cash dispensers in order to allow the customer to back out a process of keying information in the keypad which is especially useful for non-English speakers who do not understand the instructions prompted by the dispenser.

Re claims 7-11, Lion discloses a method comprising:

- providing a dispenser containing an inventory of therapeutic products;
- transmitting a proposed prescription for a patient to a server; authorizing dispensing of at least a portion of the proposed prescription out of the inventory in the dispenser if the prescription includes at least one therapeutic product available in the inventory of the dispenser;

- providing to the patient an authorization code unique to the authorized prescription, the authorization code (i.e. transaction code obtained online -col. 3 line 38-35)

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the patient inputting the authorization code into the dispenser and the patient entering separate patient authorization data (i.e. PIN or credit card number) into the dispenser; the dispenser determining whether the authorization code correlates to the patient authorization data; and

the dispenser delivering the available therapeutic product to the patient in response to the patient inputting the authorization code;

wherein the authorization step is done without intervention of a pharmacist; wherein the patient receives the therapeutic agent from the dispenser without the intervention of a pharmacist (col. 2 lines 35-65); wherein the authorization code is given to the patient by a health care provider at a health care facility (mail order or online);

Lion is silent with respect to the authorization code not capable of being reused for other prescriptions.

However, Lion teaches that the authorization code for a prescription is obtained online after the customer making the online transaction for the prescription (col. 3 lines 38-35).

It would have been obvious to one of ordinary skill in the art at the time the invention was made that the authorization code/transaction code is incapable of being reused at least by the patient for other prescriptions since the patient is inherently required to get online again to make another transaction and get another "transaction code" for other prescriptions or other prescription not in the transaction);

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3. Claim(s) 12-13, 15-16 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoomen (US 6,230,927) in view of Williams et al. (US 6,036,812) and Chudy (US 6,370,841)

Regarding claim(s) 12, Schoonen discloses a method comprising giving the unique one-time drug identification code as the authorization code for multiple drugs in a prescription by a doctor stored on customer's chip card or transmitted to the server computer at a pharmacy location where the automatic dispenser is located, wherein said authorization code can be used to obtain one time for a single prescription for drugs that are prepackaged in cartridge for the customer/patient to pickup when the patient/customer enters said authorization code into the dispenser without intervention of a pharmacist; wherein the doctor can be interpreted as being a healthcare provider at a health care facilities such as hospital or a physician's office (see abstract, col. 1 lines 20-65, col. 7 lines 1-5)

wherein the dispenser is authorized to dispense the whole prescription out of the dispenser's inventory if the prescription drug is available for dispense, otherwise the patient will receive nothing; and wherein the authorizing is done by the doctor who saves the prescription in the patient's card, therefore intervention by pharmacist is unnecessary (see abstract, col. 1 lines 20-65, col. 7 lines 1-5).

wherein before delivery, the dispenser checks the cartridge 1 (Fig. 1A-B) identification code and the drug identification code inherently on a label (col. 3 lines 30-45: each packaged drug has a printed barcode label on) associated with the drug stored

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in the cartridge and conveyed by a gripper/resilient finger 14, 39 controlling means (col. 2 lines 35+, Fig. 1A-B, 3A)

Schoonen further does not teach or fairly suggest the dispenser labeling the therapeutic product with information unique to the adjudicated prescription.

Williams et al. teach a dispenser (Figure 6A) having a robotic arm 25 that places the pill bottle 50 on label printer and applier 54 so that the prescription label with desired patient and prescription information can be included on the label that is printed and applied to the bottle 50. The label gets the information to be printed on the label such as patient name, drug, and instructions from computer 44. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Williams et al. so that the labeling time is freed up for the pharmacy technician or pharmacist to perform other work. Also, the use of the robot for labeling the prescription containers prevents contamination of prescription caused by the adhesive in the labels when being handled.

Schoonen/Williams is unclear with respect to the labeled information is unique with adjudicated prescription.

Chudy discloses a label having a barcode with customized information unique to a prescription and tailored to operator's needs; the label can have hospital name, doctor's name, and other patient-specific information (Fig. 23-24, col. 24 lines 25+). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Chudy's teachings so that information other than the adjudicated prescription can be read by pharmacy technicians so that in case when the

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patient is in need of, for example emergency medical attention or an language interpreter, appropriate actions is taken.

Regarding claim(s) 13, Schoonen discloses the data includes a one-time-use authorization code associated with only the adjudicated prescription. See abstract, col. 1 lines 20-65, col. 7 lines 1-5.

Regarding claim(s) 15, Schoonen discloses the therapeutic product is delivered to the patient without the intervention of a pharmacist. See abstract, col. 1 lines 20-65, col. 7 lines 1-5.

Re claim(s) 16, Schoonen discloses adjudicating the proposed prescription into an adjudicated prescription is done without the intervention of a pharmacist. See abstract, col. 1 lines 20-65, col. 7 lines 1-5.

4. Claim(s) 14 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoonen (US 6,230,927), modified by Williams et al. (US 6,036,812) and Chudy (US 6,370,841), further in view of Monich et al. (US 6,335,907). The teachings of Schoonen/Williams et al/Chudy have been discussed above.

Schoonen/Williams et al/Chudy combined lacks the authorization code not being reused.

Monich et al. disclose that "usually a prescription from a physician includes: name of medication and dosage/strength, number of pills (or some other measure of quantity) and frequency, number of repeats allowed, name of user, prescribing doctor, date issued" (col. 12 lines 10+).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an authorization code issued by a doctor on a card taught by Schoonen/Williams/Chudy and having a doctor's prescription issued date as taught by Momich et al. for comparison in obtaining prescription to avoid stealing from unscrupulous or drug dependent individuals who may steal/snatch the card from the patient to obtain drugs. It would also have been obvious to one of ordinary skill in the art that the issued date could further includes or incorporate a timestamp. This timestamp together with the date stamp would allow the prescription code to be invalidated for obtaining drugs from the dispenser.

Remarks

5. Applicant's arguments have been fully considered but they are not persuasive.

In response to Applicant's arguments with respect to the combination of Schoonen/Williams/Chudy would not produce the claimed invention (page 7). It is submitted that the Schoonen discloses the scanning of the drug to verify proper drug before dispensing it to the patient (col. 1 lines 1-37, col. 2 lines 30-50). Schoonen further discloses scanning (col. 3 lines 30-45: each packaged drug has a printed barcode label on) before dispensing of the drug. Williams discloses a labeler that puts labels onto the prescription container (Fig. 9, col. 8 lines 61-col. 9 line 17).

Claims 1 and 7 are now rejected with a different art which is considered closer match with the amended claim limitations.

Conclusion

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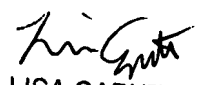
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Lion (5,838,575) discloses a dispenser that prints and applies a label and further includes a scanner to double check the label.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien T. Mai whose telephone number is 571-272-8283. The examiner can normally be reached on Monday through Friday, 8:00 - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Thien T Mai
Examiner
Art Unit 2876


LISA CAPUTO
PRIMARY PATENT EXAMINER

TM

November 07